REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed November 9, 2004. In the Office Action, objections were raised against claims 1-2, 16-17, and 19. In addition, claims 7-10, 17, 18 and 20 were rejected under 35 U.S.C. §102(e), and claims 1, 3, 4, 11 and 13-15 were rejected under 35 U.S.C. § 103(a). Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Claim Objections

Claims 1 and 17 were objected based on minor informalities. In response, claims 1 and 17 have been amended. Withdrawal of this objection is respectfully requested.

Claims 2, 16, and 19 are objected to under 37 CFR §1.75(c). Claims 2 and 19 have been cancelled without prejudice and claim 16 has been amended. Withdrawal of this objection is also respectfully requested.

Rejection Under 35 U.S.C. § 102(e)

Claims 7-10, 17, 18, and 20 were rejected under 35 U.S.C. §102(e) as being anticipated by Lee (U.S. Patent No 6,535,493). Claim 9 has been placed into independent form to include limitations of base claim 7 while claims 8 and 10 now depend on claim 9. Applicants respectfully traverse the rejection because a *prima facie* case of anticipation has not been established for independent claims 9 and 17. For clarity purposes, the grounds for traversing the dependent claims shall not be discussed in detail since Applicants believe that the above-identified independent claims are in condition for allowance. Applicants reserve the right to present such arguments if an Appeal is warranted.

As the Examiner is aware, to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Vergegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

With respect to both independent claims 9 and 17, Applicants respectfully submit that Lee does not describe a logic circuit to receive a message from a second access point, where the message includes information that comprises *a subnet mask* pertaining to (or of) the second sub-network. *Emphasis added.* Page 4 of the Office Action states that such teachings are described at column 8, lines 21-28 of Lee where Lee describes a message (Agent Advertisement packet) that allegedly has "information [that] comprises a subnet mask pertaining to said second sub-network." Applicants respectfully disagree with this statement because the Agent Advertisement packet, having a format described in detail at column 5, lines 49-60 of Lee, does not feature a subnet mask of the second sub-network (i.e., sub-network of foreign agent) as claimed.

Furthermore, Applicants respectfully submit that Lee does not describe a logic circuit that is adapted to transmit a request for a new network protocol address valid for the second sub-network (sub-network of foreign agent) *if the logic circuit determines the current network protocol address is not valid for the second sub-network or the new network protocol address has been previously stored in memory and associated with the second sub-network*, as recited in the presently pending claims. *Emphasis added.* In contrast, Lee describes an Agent Advertisement packet that is designed to signify a sub-network change in order to cause the wireless unit to generate a registration request packet to begin establishment of a tunnel between the home agent (Old AP) and the foreign agent (new AP). Such tunneling teaches away from the claimed invention which is directed toward establishment of a new network protocol address, not continued use of the old network protocol address that such tunneling provides.

In light of the foregoing, Applicants respectfully request the Examiner to reconsider the patentability of claims 9 and 17 as well as those claims dependent thereon.

Rejection Under 35 U.S.C. § 103(a)

Claims 1, 3, 4, and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of Kobayashi (U.S. Patent No. 5,724,346). Furthermore, claims 13 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kobayashi and claim 15 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kobayashi and Lee. Applicants respectfully traverse these rejections in their entirety. For clarity purposes, the §103(a) rejection of claims 13 and 14 is moot because the limitations of claims 14 and 15 have been incorporated into independent claim 13. Hence, the grounds for traverse shall not be discussed in detail as well as the grounds for traversing the rejections associated with the dependent claims.

With respect to independent claim 1, Applicants respectfully agree with the Examiner that Lee does not teach or suggest the wireless unit determining that the current network protocol address is not valid for the second sub-network if the wireless unit has not previously stored said network protocol address. However, Applicants respectfully submit that column 12, lines 16-21 of Kobayashi does not teach or suggest this limitation. In fact, the master-station management table (25) of Kobayashi is for storing the addresses of *connectable* access points obtained by search controls, and does not provide any teaching as to what the "connection impossible" status is directed to. It may be directed to a situation where the AP is on the sub-network but the AP is down, not the situation where the AP is on a different sub-network.

In summary, neither Kobayashi nor Lee, alone or in combination, provides any suggestion of using the "connection impossible" status within the table to determine whether the current network protocol address is not valid for a specific sub-network. Hence, Applicants respectfully request the Examiner to withdrawal the §103(a) as applied to independent claim 1.

With respect to independent claim 13, Applicants respectfully submit that neither Lee nor Kobayashi, alone or in combination, suggest a logic circuit for periodically transmitting a message to a wireless unit without any predetermination by the access point that the wireless unit has moved from a first sub-network to a second sub-network, where the message comprises information *including a network protocol address and a subnet mask identifying that the access point is coupled to said second sub-network. Emphasis added.* Applicants agree with the

Examiner that Kobayashi does not disclose such limitations, but disagree with the statement that Lee provides such teachings. The grounds for traversing this statement has been previously described above in the discussions regarding the lack of anticipation of independent claims 9 and 17. Hence, Applicants respectfully request the Examiner to withdrawal the §103(a) as applied to independent claim 13.

In order to facilitate prosecution of the subject application, Applicants respectfully request the Examiner to contact the undersigned attorney if further discussion is necessary to convince the Examiner as to the allowabilty of the pending claims. The undersigned attorney can be reached at the telephone number listed below.

Conclusion

In view of the remarks made above, it is respectfully submitted that the pending claims define the subject invention over the prior art of record. Thus, Applicants respectfully submit that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. Again, the Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

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Dated: 02/09/2005

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